

from the case law the incorrect conclusion that functional language can never be given weight in an apparatus claim.

In reality, the cases cited by the Examiner do not stand for the proposition that the language within Applicant's claims should not be given any weight. Rather, it is well established that functional language can distinguish structure claims from prior art.

The Examiner himself quotes Ex Parte Masham, 2 U.S.P.Q. 2d 1647 (Fed Circuit 1987) as stating that the statement for "high temperature treatment of substrate" does not merit patentable weight *unless* the body of the claim refers back to, is defined by, or otherwise draws life and breath from such intended use. Claim 53 *clearly refers back* to this intended use by reciting a position "allowing treatment of the substrate upon the support structure."

However, the Examiner additionally states that this recitation of "allowing treatment of the substrate upon the support structure" has not been given any patentable weight, and cites In re Fuller, 1929 C.D. 172; 388 O.G. 279 for the proposition that "means" language must be used in order for any functional recitation to be given patentable weight. Again, this is a legally incorrect finding. The issue is not whether "means" language is employed, nor is it whether functional language is being used. Rather, the question at bottom is simply whether the claimed invention is taught or obvious over the prior art. Talismanic reference to functional language cannot be used to simply *ignore claim language*.

The case law is replete with examples of functional language being used to distinguish apparatus claims from prior art. See, e.g., In re Schreiber, 44 U.S.P.Q.2d 1429, 1432 (Fed. Cir. 1997) ("A patent applicant is free to recite features of an apparatus either structurally or functionally. *'There is nothing intrinsically wrong with defining something by what it does rather than what it is in drafting claims.'*") (emphasis added; internal citations omitted); In re Venezia, 189 U.S.P.Q. 149, 151-52 (CCPA 1976) ("The claimed invention does include present structural limitations on each part ... For example, paragraph 2 of claim 31 calls for 'a pair adapted to be fitted over the insulating jacket of one of said cables.' *Rather than being a mere direction of activities to take place in the future, this language imparts a structural limitation to the sleeve.* Each sleeve is so structured or dimensioned that it can be fitted over the insulating jacket of a cable").

Furthermore, the Manual of Patent Examining Procedure itself clearly states that a limitation reciting the function of a particular structure "*must be evaluated and considered, just*

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like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art.” M.P.E.P. § 2172.05(g) (emphasis added). Additionally, please see the following statement of the law per the Manual of Patent Examining Procedure:

Intended use recitations and other types of functional language ***cannot be entirely disregarded***. However, in apparatus, article, and composition claims, intended use must result in a structural difference between the claimed invention and the prior art in order to patent the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim limitation.

M.P.E.P. § 2111.02 (emphasis added).

In the present case, the Examiner has not shown and cannot show that the prior art structure was capable of performing the recited functionality. In the present example, in order to perform the functions set forth in the pending claims, the prior art structures must have been specifically designed to perform those functions, which they clearly were not, on the face of the references. Because the prior art was not capable of performing the recited functions, the functional language does serve to ***structurally*** distinguish the prior art.

Thus, Applicant submits that, once proper weight is given to the functional limitations recited by Applicant, the distinctions of the claims over the prior art are clear, as is set forth in detail in Applicant’s prior response. See Amendment and Response to Office Action mailed on April 22, 2002, the remarks of which are incorporated herein by reference. Nevertheless, for completeness sake, Applicant summarizes herein below the deficiencies in the prior art.

Bahng (U.S. Patent No. 5,199,483), for example, teaches a ***dedicated*** cool down chamber, thereby increasing the throughput of an associated ***multi-chamber*** semiconductor wafer processing system.” Column 2, lines 39-43 (emphasis added). Thus, Bahng not only fails to teach an apparatus that accomplishes the recited functions, but in fact teaches away from treatment and cooling positions within the same chamber.

Similarly Hughes (U.S. Patent No. 5,181,556) teaches a “substrate cooling station” that is separate from the processing chamber. See Hughes at column 4, lines 41-43.

Kroeker (U.S. Patent No. 6,000,227) discloses a “wafer cooling system built into the transfer chamber” (Column 2, lines 32-35), while distinguishing process chamber from transfer chambers, which hold the substrate for transport from one processing chamber to another processing chamber.

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Finally, Ohmine et al. (U.S. Patent No. 5,991,508) is cited for teaching all the claim limitations except for the heat exchange member, and is combined with Bahng for supplying that teaching. However, as clearly set forth in Applicant's prior responses, Bahng does not teach such a thermal exchange member within the processing chamber, such that it does not make up for the deficiencies of Ohmine et al.

Furthermore, the Patent Office is under an obligation to employ *reasonable* claim interpretations, and to be *consistent* in its interpretations among different patents.

Although the PTO must give claims their broadest reasonable interpretation, this interpretation must be consistent with the one that those skilled in the art would reach...Accordingly, the PTO's interpretation of claim terms should not be so broad that it conflicts with the meaning given to identical terms in other patents from analogous art.

In re Cortwright, 165 F.3d 1353, 49 U.S.P.Q.2d 1464, 1467 (Fed. Cir. 1999).

In the present case, contrary to the Federal Circuits admonishments in In re Cortwright, the identical functional language was allowed in a sister application (U.S. Patent No. 6,209,220). Moreover, the Examiner's statement of reasons for allowance in that patent relied upon functional language for distinguishing the apparatus claims from the prior art.

Accordingly, Applicant's submit that the Examiner's interpretations are (1) inconsistent with the case law and the MPEP, which does not forbid the use of functional language in apparatus claims which, in fact has been used throughout the case law to distinguish prior art that does not teach structures meeting the functional limitations; and (2) is inconsistent with interpretations given by the PTO in related Application No. 09/438,200, filed November 12, 1999, now U.S. Patent No. 6,209,220, issued April 3, 2001.

At bottom, the cited prior art simply does not teach or suggest the structures recited in the claims, even if those structures are claimed by way of functional language. The claim language does not merely state an intended use, but an apparatus configured to, or capable of performing certain functions. The cited prior art does not and cannot perform those functions, nor is there any suggestion in the art to modify the prior art so that it could or would perform those functions.

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CONCLUSIONS

In view of the forgoing remarks, Applicant respectfully requests reconsideration of the rejections, and submits that the claims are allowable over the art of record. If, however, the Examiner feels that some issue remains that can be addressed by Examiner Amendment, the Examiner is cordially invited to call the undersigned for authorization.

Respectfully submitted,

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